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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,077	10/06/2000	Paul Bilibin	PSTM0020/MRK/STM	3148

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EXAMINER	
WEBB, JAMISUE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/685,077	Applicant(s) BILIBIN ET AL.	
	Examiner Jamisue A. Webb	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-57 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-57 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 06 October 2000 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5,6,7.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The declarations filed with the Information Disclosure Statement #6, filed 8/22/01, are not considered to be proper IDS references. They have been reviewed and considered and placed in the file, however are not considered to be a "reference cited".

Specification

2. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-3, 8-10, 15-17, 22-24, 29-31, 36-38, 43, 48,and 53 recite the limitation "each user client computer device". There is insufficient antecedent basis for this limitation in the

claims. The claims have previously recited a client computer device, but have not claimed a user client computer device, therefore it is unclear if they are one in the same.

6. With respect to Claim 1, 3, 8, 10, 15, 17, 22, 24, 29, 31, 36, 38, 43, 48 and 53: the phrase "rules for each of a plurality of carriers" is indefinite. It is unclear as to each what, of a plurality of carriers. Is this "each carrier of a plurality of carriers"? It is unclear to the examiner what the word "each" is referring to, therefore it is unclear what or who the rules apply to or for.

7. With respect to Claims 4, 11, 18, 25, 32 and 39: the phrase "identify as a supporting carrier each carrier for which the calculated dimensional weight of the particular parcel calculated for the carrier does not exceed a set of dimensional weight limitations for the carrier" is indefinite. This portion of the claim is a run on sentence, therefore causing the claim to be unclear and ambiguous. So it is unclear what is being identified and what is being calculated. The examiner suggests the use of commas, in the claims to clarify what is exactly being claimed.

8. With respect to Claims 5, 12, 19, 26, 33 and 40: the phrase "each of a plurality of services" is indefinite. It us unclear as to what "each" is referring to. Is this each service of a plurality of services?

9. With respect to Claims 6, 13, 26, 27, 34, and 41: the phrase "calculate the shipping rate" is indefinite. The previous claims, on which these depend on, have already claimed the step of calculating a shipping rate? Therefore it is unclear to he examiner if this is a second calculation or a further limitation of the previous calculation.

10. Claims 7, 14, 21, 28, 35 and 42 recite the limitation "the particular user". There is insufficient antecedent basis for this limitation in the claims. Previously in the independent

claims, it was recited "any particular user", therefore it is unclear which user is "the particular user".

11. With respect to all claims: throughout the claims the applicant has used the terms "billable weight", "dimensional weight" and "ratable weight". In the specification the only definition given of these different rates, are that the ratable weight is based on the calculation of the dimensional weight and the billable weight, the dimensional weight is based on the actual weight and the physical dimensions, and the billable weight is based on the dimensional weight and the actual weight (which is already factored into the dimensional rate). It is unclear to the examiner what the actual differences are between these three rates due to the fact that the application does not specify any calculations or equations used to obtain these weights. Therefore for examination purposes, the examiner is considering these to be the same thing. That the billable weight and the ratable weight is the same as the dimensional weight.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-14, 22-35, and 43-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

14. The basis of this rejection is set forth in a two-prong test of:

a. whether the invention is within the technological arts; and

b. whether the invention produces a useful, concrete, and tangible result.

15. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pas muster, the recited process must somehow apply, involve, use or advance the technological arts. In the present case, Claims 1-14, 22-35, and 43-52 only recites an abstract idea. The recited steps of merely applying rules to a set of information, identifying carriers that supports those rules, and calculating dimensional rates does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user of by use of a pencil and paper. Even though the claim recites the user accessing a computer system, the these steps only constitute an idea of how to apply these rules to choose one carrier over another, they do not require the use of the computer system to do them.

16. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is a positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps require anything in the technological arts, as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore the preamble is taken to merely recite a field of use.

17. Additionally for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces calculated rates for carriers used in selecting a specific service for shipping (i.e., useful and tangible).

18. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, Claims 1-14, 22-35 and 43-52 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-6, 8-13, 15-20, 22-27, 29-34, 36-41, and 43-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholls et al. (5,485,369).

21. With respect to Claims 1-5, 8-12, 15-19, 22-26, 29-33, 36-40, and 43-57: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to (column 4, lines 8-24, and columns 15-27) collect parcel specifications, such as weight and dimensions (Figures 4A and 4B), and determines a dimensional weight (Columns 21 and 22, line 65) and uses the weight to calculate rates for the shipment (column 5, lines 34-40, columns 25 and 26, line 39). The examiner considers this to be a dimensional weight calculation rule.

Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

22. With respect to Claims 6, 13, 20, 27, 34, and 41: See Column 8, lines 43-55.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

24. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

25. Claims 7, 14, 21, 28, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et a. in view of Kara et al. (6,233,568).

26. Nicholls, as disclosed above for claims 3, 10, 17, 24, 31 and 38, discloses the use of calculating rates for multiple carriers, but discloses the automatic selection of the carrier, and fails to disclose displaying all of the rates to the user. Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. See Kara, column 22

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dlugos (5,914,463) discloses that using a dimensional weight is old and well known in the art, as well as discloses the use of a dimensional weighing machine, Vaghi (6,047,273) discloses the use of a method of shipping where multiple shipping rates are given for multiple carriers, Thiel (6,035,291) discloses the use of an automatic selection of carrier from a plurality of carriers Boucher (6,078,889) discloses the use of a carrier library, Piccione (4,495,581) discloses the use of a postal rate calculator with multiple carrier selection, Danford-Klien et al. (6,047,271) discloses a computer rating system for multiple carriers, Hisbani et al (EP 0943904) discloses calculated rates being based on the class of service provided for shipping, and ABF freight systems (www.abfs.com) discloses a press release of a program that calculates shipping rates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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